DETAILED ACTION

Applicants' arguments, filed March 08, 2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Election by Original Presentation

Newly submitted claims 8 and 9 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally claimed invention is directed to "a cosmetic composition" and new claims 8 and 9 are directed to "a method".

Group I, claim(s) 1-7, drawn to a cosmetic composition.

Group II, claim(s) 8-9, drawn to a method for providing gloss on lips and moisture feeling by applying the cosmetic composition according to claim 1 or 7.

The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking the claims is a compound of general formula (I). Prior art exists which causes the compound in the current application to lack a special technical feature, specifically Mitsumatsu et al. (WO 02/19977) disclose pentaerythritol ester oil on page 27-28 with R groups encompassed by the instant claims.

As a result, no special technical feature exists among the different groups because the inventions in Groups I and II fail to make a contribution over the prior art and are therefore not "special."

Restriction is required under 35 U.S.C. 121 and 372.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8 and 9 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

Claim 7 is objected to because of the following informalities: "*2" is present in the claim and appears to be an error. Appropriate correction is required.

Claim Rejections - 35 USC § 103

1) Claims 1-3 and 6-7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 02/19977). This rejection is maintained.

Applicant's Arguments

Applicant argues Mitsumatsu discloses a hair care composition comprising a pentaerythritol ester oil having a formula, which is similar to those of the compounds described in Examples 1 and 2 and Comparative Example 1 of the present application. However, only the use of the pentaerythritol ester with two or three benzoic acid residues can provide the surprisingly superior results. Applicant's arguments have been fully considered but they are not persuasive.

Examiner's Response

In regard to the pentaerythritol ester of Mitsumatsu, the reference discloses where R^2, R^3 and R^4 are defined as aryl groups, which encompass the limitation of two

or three benzoic acid residues, and therefore would reasonably lead one skilled in the art to the claimed composition.

In regard to Applicant's alleged unexpected results, as previously asserted it appears the results are for lipstick compositions, i.e. "gloss on lips", and the scope of the rejected claims encompass more than lipstick. Specifically, claim 1 recites the limitation of the genus of a "cosmetic composition". Thusly, it can not be concluded that results for "gloss on lips" can be extrapolated to any cosmetic composition, since different testing conditions would be used with different compositions on different substrates, i.e. hair or skin. Differences between the claimed invention and the prior art's pentaerythritol esters would be expected to result in some differences in properties. It appears Applicant's results show statistical variation, which is expected (see discussion under the Declaration section, *infra*). Therefore, more gloss seen in the compositions of the declaration does not appear to be an unexpected result. Furthermore, there is no error analysis for the reported results and thus it cannot be independently determined if the results are or are not within experimental error. The results do not appear to be unexpected, but purely *arguendo*, assuming the results are unexpected, Applicant's claims encompass more compounds, i.e. esters of pentaerythritol, than that disclosed by the Table in the specification and the declaration, therefore the Examples are not commensurate in scope with the instant claims.

2) Claims 4 and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 02/19977) as applied to claims 1-3 and 6-7 above in view of Healy et al. (WO 00/26285). This rejection is maintained.

Applicant's Arguments

Applicant argues the Office is incorrect to compare the unexpected results presented in the Hosokawa Declaration to the combined teachings of Mitsumatsu in view of Healy; rather, they must be compared to those of the single closet prior art. As stated in the MPEP 716.02(e) III.

Examiner's Response

Examiner respectfully disagrees with Applicant's interpretation of the MPEP. It appears MPEP 716.02(e) III states, Applicant is required to compare evidence of unexpected results of the claimed invention with the closest prior art and Applicant is not required to compare the claimed invention with the invention of the combination of references relied upon in the rejection of the claimed invention; however it does not appear to say the Examiner may not analyze the evidence based on what is taught by the prior art. Therefore, Examiner's response to Applicant's arguments filed August 11, 2009 is proper. In regard to Applicant's alleged unexpected results, differences between the claimed invention and the prior art's pentaerythritol esters would be expected to result in some differences in properties. It appears Applicant's results show statistical variation, which is expected. Therefore, more gloss seen in the compositions

of the declaration does not appear to be an unexpected result. The results do not appear to be unexpected, but purely *arguendo*, assuming the results are unexpected, Applicant's claims encompass more compounds, i.e. esters of pentaerythritol, than that disclosed by the Table in the specification and the declaration, therefore the Examples are not commensurate in scope with the instant claims.

Declaration

Applicant's declaration purports to show the superiority of the use of dibenzoic acid-2-ethylhexonic acid behenic acid pentaerythritol ester, which R_1 is a 2-ethylhexanoic acid residue and R_2 is a behenic acid residue in the formula (I) in the claim 1.

Differences between the claimed invention and the prior art's pentaerythritol esters would be expected to result in some differences in properties. It appears Applicant's results show statistical variation, which is expected. In particular, there are differences in results between Applicant's claimed pentaerythritol esters of Exp. A & B and Ex. 1 & 2, in which when increasing the amount of esters by the same, results in varied results, i.e. between Exp. A & B, 7 out of 10 and 9 out of 10 say the compositions have good gloss and between Ex. 1 & 2, 7 out of 10 and 10 out of 10 say the compositions have good gloss, which supports that statistical variation is expected. Applicants results for "gloss of lips" for Exp. A and Ex. 1 shows 7 out of 10 people said the composition provided good gloss where as for Comp Ex 2, 5 out of 10 said this

compositions provided good gloss. Therefore, more gloss seen in the compositions of the declaration does not appear to be an unexpected result. Further, it is difficult to ascertain based on the Declaration what constitutes good or not good gloss. It is not clear if one composition has more gloss or if there is no gloss or how much gloss is good. Furthermore, it does not appear that the difference in the results would be considered "unexpected" but more of a variance of opinion. It does, however, appear that the results are better for "cosmetic durability"; however there is no disclosure of what constitutes "cosmetic durability"; i.e. stability. The results do not appear to be unexpected, but purely *arguendo*, assuming the results are unexpected, Applicant's claims encompass more compounds, i.e. esters of pentaerythritol, than that disclosed by the Table in the specification and the declaration, therefore the Examples are not commensurate in scope with the instant claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612